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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,126	12/18/2001	Kinya Tsuchiyama	15176	4786
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SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			EXAMINER FOSTER, ROLAND G	
			ART UNIT 2645	PAPER NUMBER

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,126

Applicant(s)

TSUCHIYAMA, KINYA

Examiner

Roland G. Foster

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2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,044,275 ("Boltz"), of record, in view of U.S. Patent No. 6,654,790 B2 ("Ogle"), newly cited.

With respect to claim 1, Boltz discloses a mobile information terminal apparatus (Fig. 3 mobile station "MS" 300), means for generating character mail (Fig. 3, SMS 310 and col. 4, lines 20-43) (where SMS is character mail, see col. 2, lines 8-25), means for setting transmission time of the SMS message (character mail) and means for checking the time and transmitting the message when the system time matches the predetermined time (abstract and col. 4, line 64 – col. 5, line 8).

Although Boltz discloses SMS (short message service) as discussed above, Boltz fails to disclose an additional means for setting the normal short mail service or setting an alternative delivery mechanism (i.e., another type of mail as the character mail).

However, Ogle (similarly to Boltz) is directed to a mobile information terminal (Fig. 2, cellular telephone 10) providing character mail transmission (abstract), where the user is provided a means for selecting alternative delivery mechanisms (i.e., another type of mail as the character mail) such as pager, cell phone, screen phone, regular phone, PDA, e-mail, etc. (col. 10, lines 18-36) over media such as Ethernet or Token Ring LAN, cellular modems, computer modem, etc. (col. 6, lines 29-45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a means for selecting the alternative delivery mechanisms (i.e., another type of mail as the character mail) as taught by the system of Ogle (directed to mobile

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terminal providing character mail transmission) to the system as disclosed by Boltz (also directed to a mobile terminal providing character mail transmission).

The suggestion/motivation for doing so would have been to increase the efficiency, flexibility, and user-friendliness of character mail transmission by allowing the user to select alternative delivery mechanisms, which would have provided an alternative to inefficiently "completely discarding" the sender's message when recipient is not available, providing a more "suitable" delivery mechanism in the "many cases [where] the sender's message is not time-critical", and increase the availability of the recipient in cases where "he is not currently reachable by an IMS" but "reachable by an alternative communication (such as cellular phone, page, etc.)" (Ogle, col. 2, lines 1-24).

Claim 6 differs substantively from claim 1 in that claim 6 recites additional limitations directed to the basic constituent elements of a mobile telephone system. Thus, the claim reads on the mobile telephone with SMS (character mail) disclosed by Boltz as modified. For example, the limitation "antenna" reads on the antenna illustrated for MS 300. The limitation "transmitting and receiving an arrival and departure number and required information to a from the base station" reads on the disclosed call and message placement and reception process via the mobile telephone network, which requires numbers to identify the mobile station and base station. The "wireless section" reads on the illustrated MS telephone antenna (Fig. 3). The MS 300 receives and transmits messages over a GSM, AMPS, and PCS network (e.g., col. 5, lines 40-45), therefore a base-band section is required for coding data into the appropriate format

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suitable for transmission over the telephone network (e.g., GSM) for decoding the received, coded data. The "keyboard" for inputting character "like" information and the "display indication" for displaying received mail and information "like" information reads on the illustrated MS telephone antenna (Fig. 3). The "transmission information management area" reads on subscriber identity module (SIM) card (Fig. 5 and col. 4, line 63 – col. 5, line 12). The MS 300 inherently comprises a central processing section for implementing the computer functions discussed above.

Claim 11 differs substantively from claim 1 in that claim 11 is much more broadly recited. Therefore, see the claim 1 rejection for further details.

With respect to claims 2 and 7, see claim 1 where the generated character mail is generated at one time, stored, and transmitted at a later time.

With respect to claims 3, 8, and 12, see Boltz, col. 4, lines 20-30.

With respect to claims 4, 9, and 13, although Boltz as modified teaches that the transmission time and the character generation time (e.g., message generation) time can be set separately, Boltz fails to disclose that the transmission time can be set after the generation time.

However, "Official Notice" was taken in the prior Office action of the concept and advantages of message delivery systems that allow the user to set transmission times after the

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message generation time. The applicant's lack of traverse to the officially noticed fact in the last Office action is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability to set transmission times after character generation time to the message delivery system of Boltz in view of Ogle that allows the transmission and generation time to be set separately.

The suggestion/motivation for doing so would have been to increase the flexibility of a message delivery system, by allowing the user to modify delivery times after the message are stored. In addition, versatility would have been increased because the user would be able to tailor message delivery times as scheduling information becomes better known. Finally, efficiency would have been increased because the user could have modified the message delivery time, rather than being forced to inefficiently re-enter (generate) the message before the scheduling is modified.

With respect to claims 5, 10, and 14, Boltz discloses that the user enters a transmission time in advance for every message and thus for every transmission destination associated with the message.

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With respect to claims 15-17, the alternative delivery mechanisms added by Ogle to Boltz in the claim rejections above included delivery over an Ethernet LAN, which is a packet based network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
January 5, 2005